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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,802	10/30/2003	Koyata Takahashi	Q78274	6874

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EXAMINER	
WATKINS III, WILLIAM P	

ART UNIT	PAPER NUMBER
1772	

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/695,802	TAKAHASHI ET AL.	
	Examiner	Art Unit	
	William P. Watkins III	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 October 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,7-13 and 18-20* is/are pending in the application.

4a) Of the above claim(s) *6 and 14-17* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,7-13 and 18-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☒ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *09 June 2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-5, 7-13, and 18-20 are drawn to an island projection modified part, classified in class 428, subclass 141.

II. Claims 6 and 14-17, drawn to a method of making an island modified part by plasma spraying, classified in class 427, subclass 446.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions Group II, claims 6, 14-17; and Group I, claims 1-5, 7-13 and 18-20 are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the

product as claimed could be made by coating a glass layer and embossing it with a desired surface pattern.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and since the fields of search are not co-extensive, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Mark Boland on 1 February 2005, a provisional election was made without traverse to prosecute the invention of Group I, claims 1-5, 7-13 and 18-20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 6, 14-17 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must

be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1-5, 7-13, 18-20 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Takahashi et al. (U.S. 2004/0018361 A1).

The reference discloses a thermal sprayed quartz film on a quartz substrate used in a CVD or PVD device, with surface features of 5 to 100 microns in dimension (abstract, claim 1). It is unclear how it differs if at all from the thermal sprayed quartz film of the instant invention. As the PTO does not have facilities to conduct comparison experiments, burden is shifted to applicant. This is a 102/103 type of rejection. MPEP 2112 and 2113. It is noted that applicant has not perfected priority nor supplied a translation of the priority document nor made any statement of common ownership at the time of the instant invention.

9. Claims 1, 7-13, 18-20 are rejected under 35 U.S.C. 102(a and e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Takahashi et al. (U.S. 2003/0091835 A1).

The reference teaches thermal spraying of various ceramics onto a glass substrate used in a PVD or CVD machine (abstract, claim 1). It is unclear how it differs if at all from the

thermal sprayed film of the instant invention. As the PTO does not have facilities to conduct comparison experiments, burden is shifted to applicant. This is a 102/103 type of rejection. MPEP 2112 and 2113. It is noted that applicant has not perfected priority nor supplied a translation of the priority document nor made any statement of common ownership at the time of the instant invention.

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1-5, 7-13, and 18-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 10/405,226. Although the conflicting claims are

not identical, they are not patentably distinct from each other because it is unclear how the claimed thermal sprayed coating differs between the instant claims and the claims of the '226 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. Claims 1, 7-13, and 18-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10/289,402. Although the conflicting claims are not identical, they are not patentably distinct from each other because it is unclear how the ceramic thermal spray of the instant claims differs from that of the '402 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

13. Claims 1-5, 7-13, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hellmann et al. (U.S. 6,150,006 in view of Takashi et al. (JP-A 04-268065).

Hellmann et al. teaches a quartz layer with a surface roughened with structural elements in the 30 to 180 micron size range in a component used in a CVD device to have good adhesion and a long service life (abstract). Takashi et al. teach the formation of a coating on a part with good adhesion to deposited films with the coating formed by thermal spraying (English abstract). The instant invention claims a thermal sprayed coating element dimensions of 5 to 300 microns. It would have been obvious to one of ordinary skill in the art to have formed the surface features of Hellmann et al. by coating a quartz substrate with a quartz thermal spray in order to have an alternate to etching because of the teachings of Takashi et al. A thermal sprayed coating that has the dimensions of Hellmann et al. is taken as meeting the instant claim language of roundish projections. As the final application conditions are similar between the instant specification and the references it would have been obvious to one of ordinary skill in the art have arrived at the claimed density of projections through a process of optimization of the thermal coating of the combination of the references.

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ohhashi et al is an equivalent to a reference cited on the IDS.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Watkins III whose telephone number is 571-272-1503. The examiner works an increased flex time schedule, but can normally be reached Monday through Friday, 11:30 A.M. through 8:00 P.M. Eastern Time. The examiner returns all calls within one business day unless an extended absence is noted on his voice mail greeting.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR of Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

William P. Watkins III

WW/ww
February 7, 2005

WILLIAM P. WATKINS III
PRIMARY EXAMINER